

REMARKS

Claims 1 through 80 are pending in this application. The Applicant appreciates the Examiner's indication of allowability concerning claims 1 through 8, 15 through 31, and 33 through 80.

I. REJECTION OF CLAIMS (35 U.S.C. § 103)

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A. Claims 9-14 and 32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumaki (5,619,229). The Applicant respectfully traverses.

1. Regarding claim 9, the Examiner stated that the only difference between the disclosure of Kumaki and the claimed invention is that the claim further requires determining color gain and cut-off data according to the maximum and minimum color temperatures.

However, the Examiner argues that since Kumaki mentions that a knob is handled to provide a color temperature by an operator (column 3, lines 43-45), it is obvious to a person of ordinary skill in the art to recognize that the operator can turn the knob to minimum or zero value or to the highest or maximum value of the knob to obtain the gain and cut-off data since the gain and cut-off data change proportionally to the input color temperature values.

Here, the teaching or suggestion to make the claimed modified version of Kumaki is not found in the prior art. As mentioned in MPEP 706.02(j), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner mentions that since a knob can be turned then there must be a minimum and maximum. However, the Examiner fails to show where in the record this evidence exists as required by MPEP 706.02(j).

If the Examiner is relying on his personal knowledge, then, according to MPEP §2144.03 relating to "Reliance on Common Knowledge in the Art or 'Well Known' Prior Art" such reliance

is not judiciously applied. Only in certain circumstances this can be done. The Examiner's use of his knowledge does not meet the standards set in MPEP §2144.03 and therefore should not be used here. Furthermore, it is the right of the Applicant to demand authority be shown for all the reliance of what the Examiner calls as common knowledge.

Moreover, the Examiner said the knob can be adjusted to a maximum and minimum value. However, the evidence must actually teach or suggest and not simply include a possibility and such a selection is never actually suggested. Being able to move a knob to a maximum and minimum does not teach or suggest determining the color gain and cut-off value according to both values and also including the user selected value. All three criteria are never specifically taught or suggested.

In addition, the actual teaching or suggestion of the claimed invention is never made. The Federal Circuit has mentioned that "[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious." *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964). Here, the present invention claims determining color gain and cut-off data according to the maximum and minimum color temperatures. However, the actual relationship of the color gain and cut-off data being according to the maximum and minimum color temperature is never actually taught on the record. Simply having a knob moved to a maximum and minimum value does not even teach or

suggest such a relationship. Rather, the Examiner is using the applicant's invention to make the modification in the teaching of Kumaki.

2. Regarding claims 10 and 14, the Examiner stated that Kumaki discloses (Fig. 6) a digital to analog (DAC) converter for converting the color gain and cut-off values of the amplifier (OP1) (column 8, lines 6-13 and lines 50-53), and it is well known in the art that the operational amplifier (OP) has gain and cut-off values. The Examiner also stated that it is well known that a D/A converter changes to analog signal.

However, the Examiner fails to show on the record that the color gain and cutoff *values* are converted to analog signal. Simply having color gain and cutoff values does not teach that such values are actually converted to an analog signal.

In addition, again the Examiner is using common knowledge liberally, and the MPEP highly discourages such heavy use as mentioned in MPEP§2144.03. Moreover, it is the right of the applicant to demand the Examiner produce that the values are converted to analog.

3. Regarding claim 11, the Examiner stated that since Kumaki mentions that a knob is handled to provide a color temperature by an operator (column 3, lines 43-45), it is obvious to a person of ordinary skill in the art to recognize that the operator can turn the knob to minimum or zero value or to the highest or maximum value of the knob to obtain the gain and cut-off data since the

gain and cut-off data change proportionally to the input color temperature values, wherein the minimum value and the maximum value of the knob is the initial color gain and cut-off values.

However, again as mentioned concerning claim 9, the Examiner has not been able to show on the record how the relationship of the gain and cut-off data is related to the maximum and minimum color temperature values.

Moreover, the claim also states that such is *before* the inputting of the selected value. Kumaki never suggests such a limitation and it is highly unlikely that common knowledge can also be used here in the rejection. There is no such teaching or suggestion and the Examiner failed to even address this point.

4. Regarding claim 12, the Examiner stated that Kumaki discloses (Figs. 1, 4, and 5) a method for color display adjustment, comprising inputting a user selected value (Fig. 1, in the color temperature adjusting unit 5, a knob is handled to provide a color temperature by an operator) (column 3, lines 43-45) since Kumaki mentions that a knob is handled to provide a color temperature by an operator (column 3, lines 43-45), it is obvious to a person of ordinary skill in the art to recognize that the operator can turn the knob to minimum or zero value or to the highest or maximum value of the knob to obtain the gain and cut-off data since the gain and cut-off data change proportionally to the input color temperature values.

However, again the Examiner is modifying Kumaki without proper motivation or suggestion

on the record as seen in the remarks of claim 9.

In addition, inputting of a user selected value is not in the range of selected range of temperatures according to a maximum and minimum color temperature. A knob alone does not teach all of those limitations.

The claim states that the value is selected within the range and the range is according to maximum and minimum values, but does not state that the range is actually the maximum and minimum values. No range is actually even selected in Kumaki, but there is only a teaching of a knob. That knob can also vary depending on other factors.

Moreover, technically, the maximum and possibly the minimum outputted by the knob for color temperature can still vary depending on the environment or other conditions, and therefore, there is no actual selected range in Kumaki. The Examiner makes many assumptions here, and it is an improper reason for rejection.

5. Regarding claim 13, again as seen in claim 9, the knob for color temperature does not suggest the limitations of the present invention. The record clearly fails to teach or suggest such a modification. Moreover, simply having a maximum and minimum value does not teach or suggest the claimed limitations.

6. Regarding claim 32, the Examiner stated that Kumaki discloses (Figs. 1, 4, and 5) a method, comprising setting a range of temperature (Fig. 4) according to maximum and minimum color temperature values (column 6, lines 27-40, wherein the minimum value is zero and the maximum value is the highest value).

The Examiner argued that a maximum and minimum of a knob is a predetermined range. However, the record never actually teaches that the knob as teaching such limitations. Moreover, the knob in itself could possibly vary in its output and thereby undermining the Examiner's assumptions based on his knowledge.

Respectfully, again, the Examiner is relying on his personal knowledge. According to MPEP §2144.03 relating to "Reliance on Common Knowledge in the Art or 'Well Known' Prior Art" such reliance is not judiciously applied. Only in certain circumstances this can be done. The Examiner, has heavily relied on this throughout the rejection. The Examiner's use of his knowledge does not meet the standards set in MPEP §2144.03 and therefore should not be used to such heavy extent. Furthermore, it is the right of the Applicant to demand authority be shown for all the reliance of what the Examiner calls as common knowledge.


Moreover, the use of common knowledge used by the Examiner was never intended to short-circuit the clear wording of 35 U.S.C. §103. A finding of obviousness must be based upon a determination of obviousness under section 103. *See In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965). *See In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995), *See also, Ex parte Edwin G. Sawdon and Brian D. Petit*, decision of the Board of Patent

Appeals and Interferences, Patent No. 6,722,842 (Appeal No. 2003-0693, application no. 09/006,248), paper No. 34 , page 7. Here, common knowledge was heavily used and used improperly to short-circuit the fact intensive requirements of 35USC§103 to provide a motivation or suggestion on the record rather than merely using common knowledge with such liberal intent.

In view of the foregoing remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Response. Should there be a deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,



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